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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/30/2003

William J. Farrell JR.

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WASHINGTON, DC 20036

EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

03/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/696,583	<b>Applicant(s)</b> FARRELL ET AL.	
	<b>Examiner</b> William V. Gilbert	<b>Art Unit</b> 3635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

This is a first action following a request for continued examination. Claims 1-21 have been cancelled. Claims 22-35 are pending and examined.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 December 2008 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3635

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 22 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Patent No. 4,611,450) in view of Strand (U.S. Patent No. 1,664,837) and Ritter (U.S. Patent No. 6,272,805).

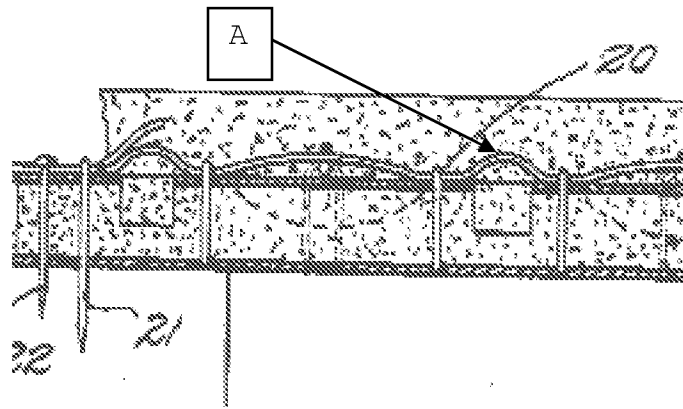
Claim 22: Chen discloses a construction panel comprising outer and inner wire mesh members (Fig. 2-3: 223), a middle member (10, 14, 16 and 30) comprising a plurality of layers comprising wire trusses and polystyrene foam (abstract, line 11), disposed between the outer and inner mesh members and positioned to define a first gap (see, e.g. Fig. 2-3: 231) between the middle member (portions 10, 14 and 16) and the outer mesh members and a second gap (Fig. 2-3: 231) between the middle member and inner mesh, the middle member is connected to the inner and outer mesh members by attaching the mesh to the

Art Unit: 3635

trusses on outside ends of said middle member (see Fig. 2-3, the apex of the truss, proximate 232), and an outer layer of a cement material (claim 8) on the members. While Chen discloses a mesh member (223), it does not disclose screed ridges with an impression having an apex projecting outwardly from the member. Strand discloses a mesh screed member (Fig. 1: 15 and 18) and having outwardly pointing apices (see "A" from attached Fig. 2 from Strand below). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mesh in Strand with the mesh in Chen because the mesh in Strand would perform equally as well as the mesh in Chen and would add a further dimension to aid in the bonding of the cementitious material to the mesh. Last, while the prior art of record discloses a cement material is a coating on the panel that extends to the apex of the mesh (see e.g. Strand Fig. 2), it does not disclose that the material is concrete. Ritter discloses a construction element with a foam core and concrete outer layers (see Fig. 16a: 13'). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have a concrete coating because as disclosed in Chen (claim 8) numerous cement based materials may be used, and concrete is a cement based material and would perform

Art Unit: 3635

equally as well depending on the desired effect of the outer layer of the panel.



**Figure 2 from Strand**

Claim 23: as shown in the obvious combination of the prior art, the screed ridges extend the entire length of the mesh members from a top end to a bottom end (see Strand Fig. 1, generally).

**Claims 24-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Strand, Ritter and Sacks (U.S. Patent No. 6,820,387).

Claim 24: the prior art of record discloses the claimed invention including a ridge as claimed, but not that the ridge is V-shaped. Sacks discloses a screed member (Fig. 2) with a V-shaped ridge (proximate 15: please note that only the shape of

Art Unit: 3635

the ridge is considered). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have this limitation because a configuration of an invention is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04. A V-shaped screed would result in a properly operating member that would function in the same manner as the screed in the prior art cited.

Claims 25-27 and 35: While the combination of the prior art cited discloses three ridges (see *Strand*, generally), it does not disclose the dimensions as claimed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions of the ridges and panels as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV)(A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a

Art Unit: 3635

recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Further, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have this limitation because optimization of an invention will not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such a limitation is critical. See M.P.E.P. §2144.05 "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454 (CCPA 1955) (Claimed process which was performed at a temperature between 40C and 80C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100C and an acid concentration 10%.)

Claims 28 and 32: Chen discloses a construction panel comprising an outer and inner wire mesh members (Fig. 2-3: 223), a middle member (10, 14, 16 and 30) comprising a plurality of layers comprising wire trusses and polystyrene foam (abstract, line 11), disposed between the outer and inner mesh members and



Art Unit: 3635

positioned to define a first gap (see, e.g. Fig. 2-3: 231) between the middle member (portions 10, 14 and 16) and the outer mesh members, and a second gap (Fig. 2-3: 231) between the middle member and inner mesh, the middle member is connected to the inner and outer mesh members by attaching the mesh to the trusses on outside ends of said middle member (see Fig. 2-3, the apex of the truss, proximate 232) and an outer layer of a cement material (claim 8) on the members. While Chen discloses a mesh member (223), it does not disclose screed ridges with an impression having an apex projecting outwardly from the member. Strand discloses a mesh screed member (Fig. 1: 15 and 18) having three outwardly pointing apices (see "A" from attached Fig. 2 from Strand above). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to sue the mesh in Strand with the mesh in Chen because the mesh in Strand would perform equally as well as the mesh in Chen and would add a further dimension to aid in the bonding of the cementitious material to the mesh. Further, while the prior art of record discloses a cement material is a coating on the panel that extends to the apex of the mesh (see e.g. Strand Fig. 2), it does not disclose that the material is concrete. Ritter discloses a construction element with a foam core and concrete outer layers (see Fig. 16a: 13'). It would have been obvious at

Art Unit: 3635

the time the invention was made to a person having ordinary skill in the art to have a concrete coating because as disclosed in Chen (claim 8) numerous cement based materials may be used, and concrete is a cement based material and would perform equally as well depending on the desired effect of the outer layer of the panel. In addition, the dimensions of the apex of the ridges would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV)(A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Last, the prior art of record discloses a ridge as claimed, but not that the ridge is V-shaped. Sacks discloses a screed member (Fig. 2) with a V-shaped ridge (proximate 15: please note that only the shape of the ridge is considered). It would have been obvious

Art Unit: 3635

at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have this limitation because a configuration of an invention is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04. A V-shaped member would still operate properly as a screed and would not depart from the concept of the prior art cited.

Claims 29 and 33: the middle member comprises a plurality of layers comprising wire trusses (Chen: 211) and polystyrene (212) between the wire mesh members and defining a gap between the middle member and the wire mesh members (see Chen: Fig. 1).

Claims 30 and 34: the middle member (Chen: portion 30) is connected to the mesh member by attaching the mesh member to trusses on outside ends of the middle member (see Fig. 1: proximate 32, which is an outside end of the middle member, as it is attached to the mesh.

Claim 31: the prior art of record discloses the claimed invention except for the dimensions of the member as claimed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design

Art Unit: 3635

choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

### ***Response to Amendment***

3. The declaration of M. Heath filed on 11 December 2008 under 37 CFR 1.132 has been considered but is ineffective to overcome the cited references. With respect to the argument relating to the Rockstead patent, the examiner respectfully notes that the patent was not used in this Office action, so it is therefore moot. In addition, objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope

Art Unit: 3635

with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.) For example, applicant states in the declaration that the mesh elements are held together with "wire C-rings" (paragraph 7). Further, applicant claims that the present invention is a "structural panel". These limitations are not provided in the claims, and the limitation "structural panel", without supporting limitations, is a very broad definition, in that virtually any panel can be classified as "structural". In addition, the examiner respectfully disagrees with applicant's assertion that the cementitious coating in the Chen reference is not vital. Chen specifically states this cementitious coating in claim 8. It is a part of the invention.

Regarding applicant's arguments to the Ritter reference, the Ritter reference was cited only to show that concrete can be

Art Unit: 3635

used as a coating, and to teach that concrete coatings are known in the art.

The declaration of W. Farrell under 37 CFR 1.132 filed 11 December 2008 is insufficient to overcome the rejection of the claims based upon the prior art cited as set forth in the last Office action because: objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.) In other words, as provided in paragraph 6 of the declaration, it appears that applicant is arguing the "commercial embodiment...as claimed in the pending

Art Unit: 3635

claims, has garnered great interest in the industry and enjoyed commercial success". Based on this statement, it appears that the applicant is arguing the narrowest claims listed (e.g., the claims with the spacing of the members as claimed, the dimensions, quantity and location of the ridges, etc.) In other words, these limitations are not commensurate in scope with the broad claims at issue, but rather the more narrow dependent claims.

In addition, applicant's argument addressing unexpected results is not persuasive because applicant's provided limitations that are not present in the claim (e.g. the device can be made form recycled material), and applicant has not provided any evidence to show its resistance to fire, termites, etc., as claimed in the affidavit.

#### ***Response to Arguments***

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as applicant amended the claims.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635  
/Basil Katcheves/  
Primary Examiner, Art Unit 3635